

United States
Circuit Court of Appeals
For the Ninth Circuit

SAMUEL EAGLE, JOHN WILLIAM LANGS,
and PLOMB TOOL COMPANY, a corporation,
Appellants,

vs.

P. & C. HAND FORGED TOOL COMPANY,
a corporation,
Appellee.

Appellants' Reply Brief

Upon Appeal from the United States District
Court for the District of Oregon

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Appellee Deliberately Copied the Eagle Wrench

Before proceeding to a consideration of the points made by appellee in its brief, it must be remembered that appellee is a deliberate infringer of appellant's patent. When it entered into the manufacture and sale

of flex-handled wrenches it copied the Eagle wrench. This is testified to by C. F. Carlborg who was then a partner and later vice-president of appellee and in charge of the shop end of appellee's business. (T. 124)

The statement that it was appellee's deliberate intention to copy is thus not based upon mere conjecture but is established by the admission of said officer. No attempt was made by appellee to explain said testimony or to refute it in any manner and thus it stands admitted on the record.

A comparative inspection of the wrenches clearly discloses that appellee deliberately chose slavishly to imitate the Eagle wrench in all of its details including color and external appearance, as well as the exact operating parts thereof. Appellants' attorney notified appellee of said infringement and instead of discontinuing said infringement appellee has engaged in expensive litigation to defend the imitation. Appellee has also attempted to improve or modify said wrench and thought enough of said modification to obtain a patent thereon (T. 129). But even though it has a patent monopoly upon said modification, appellee still continues to manufacture the Eagle wrench but yet contends herein, as a defense, that the details of the Eagle wrench are unimportant and constitute mere matters of choice.

Appellee's Defense is Technical

Appellee's entire defense is based upon the fact that appellee has searched the patent records and has discovered two wrenches patented prior to the Eagle

patent which wrenches, denominated the Edmands wrench (Pl. Ex. "D") and the Fairchild wrench (Pl. Ex. "J"), have some elements which are common to parts of the Eagle patented wrench. Because it has found said two patents, appellee presumes that the Examiner in charge of the application possibly overlooked them because he did not make them of record and that if he had considered them the single claim might not have been allowed. Appellee also contends that if a mechanic skilled in the art had said patents before him, said mechanic would perceive and conceive the answer to the troublesome problem of providing a multi-purpose, flex-handled wrench adapted to use standard sockets and that said mental concept would be self-suggestive.

Appellee's Defense is Theoretical and Does Not Follow the Experience of the Parties and the Art in General

The defense of lack of invention is based not upon the **experience** of any of their witnesses or upon the **experience** of appellee itself. It is a mere **theoretical conclusion which is entirely opposed to the experience of the art**. The various witnesses have testified that the art was eagerly looking for a wrench which would solve difficulties experienced by everyone interested in the art. Manufacturers, and mechanics as well, had their selfish reasons for attempting to solve this problem but all were unsuccessful. When Eagle solved the problem and brought his solution forward it was immediately recognized as the proper one, was seized upon, and adopted by the art, and was given such almost

universal recognition that the sale of Eagle wrenches now constitutes substantially one-half of the wrench business of the various manufacturers. No attempt is made by appellee to explain this phenomenal success experienced by itself as well as by all of the other manufacturers, except to point out that the Plomb Tool Co., one of the appellants herein, spent between ten and twelve thousand dollars in exploiting the Eagle wrench over a period of several years. It was not shown that this sum of money was an unusual expenditure and obviously it had no bearing upon the sales made by appellee and other competing manufacturers who have infringed the Eagle patent, except that they would profit unfairly from a competitor's efforts.

Appellee Gives the "Tribute of Praise to the Prior Art; It Gives the Tribute of Its Imitation to the Eagle Patent"

Appellee contends that the Edmands wrench will "do anything that the Eagle wrench will do" and relies upon said contention so strongly that its entire defense is based upon said premise. When appellee entered the field of manufacturing wrenches the Edmands wrench, which it now extols as a superior wrench, was public property. Appellee could have adopted said wrench without restriction and still can if it cares to do so. It can take advantage of its structure, which appellee contends to be more efficient and less expensive and, if this were so, could undersell appellants if it wished to do so. Appellee's actions, however, belie its contentions brought forward as a defense in this suit. It gives

the "tribute of its praise to the prior art; it gives the tribute of its imitation, as others have done, to the (Eagle) patent." Appellee contends that the single claim in the Eagle patent is narrow and this would seem to make the legal evasion easy.

"Why then was there not evasion by a variation of the details of the patented arrangements? Business interest urged to it as much as to infringement. We can find no answer except that given by the XXX Company: The patented organization must be one that is essential. Its use in the precise form described and shown in the patent must be inevitably necessary!" **Diamond Rubber Company vs. Consolidated Tire Co.** 220 U. S. 418; 55 L. Ed. 527, 534.

As is stated in appellant's brief (page 77) it is submitted that THE ART IS NEVER ADVANCED BY THE IMPLIED SANCTIONING OF DELIBERATE PIRACY WHERE THE ONLY REASON ADVANCED FOR SAID TAKING IS THAT ANYONE COULD HAVE DONE AS WELL IF HE HAD THOUGHT OF DOING IT.

The Edmands and Fairchild Patents are Not Better References: They are Only Different References

Instead of meeting these issues, appellee has set up a very technical defense, namely: that there are two patents that were issued prior to the Eagle patent which are not referred to by the Examiner in his actions on the application which matured in the Eagle

patent; that it might be presumed that the Examiner did not see and consider said patents; and that if the Examiner had seen these patents it is possible that he might not have allowed the Eagle claim.

Appellee, in its brief, does not point out in what respects the Edmands patent differs from the patent references cited by the Examiner, nor does appellee point out in what respect the Fairchild patent differs from said references. It merely contends that these are **different** references and, therefore, some substantial weight should be given to their omission from the file wrapper and that the omission of said references should affect the presumption of validity enjoyed by appellant's patent because of the issuance thereof by the patent office.

IT SHOULD BE NOTED FURTHER THAT NEITHER THE EDMANDS WRENCH OR THE FAIRCHILD WRENCH HAS EVER BEEN MANUFACTURED AND THE PATENTS ARE THUS PAPER PATENTS WHICH, FROM A PRACTICAL STANDPOINT, HAVE BEEN IGNORED BY THE ART.

It is not essential that the United States patent office in making its actions shall cite **all** of the examples of the prior art because said prior art might involve hundreds of prior patents and practical examples. The rules of practice of the United States patent office (Rule 66) require that "Upon the rejection of an application for want of novelty the examiner must cite the **best** references at his command." To have any per-

suasive value whatsoever, it is necessary to demonstrate that the references not cited by the examiner are better references in order to weaken the presumption that the Examiner has given an application for patent his careful attention.

Appellee's Defense Does Not Meet Issues but Involves Only Presumptions Based Upon Possibilities

In this case the File Wrapper discloses that Eagle as an applicant presented many different claims to the Patent Office Examiner. The Examiner considered each of the claims thoroughly and rejected all but one of said claims. It was only after a careful examination that he permitted said claim to be allowed. This careful attention given to the application by the Examiner **strengthens** the presumption of its validity rather than **weakens it**.

It appears to be appellee's contentions that the court should first construe the allowed claim to have substantially the same scope as rejected initial claim 4 which appellee has compared side by side on page five of its brief, then should hold that said claim and said construction are anticipated by Edmands in view of Fairchild. The Examiner on the other hand has held that said initial claim 4 was anticipated by Miottel in view of Helstrom. It is submitted that the Examiner carefully considered **exactly the same point which appellee now urges**. It is obviously unnecessary and highly improper to put a strained, distorted interpretation upon the single claim allowed in the Eagle patent.

Said claim is clear and needs no construction other than the one proposed by the patentee in his specification and in the remarks accompanying the claims when they were presented to the Patent Office for consideration.

Appellee's Defense Involves a Strained, Rather than a Natural Interpretation of the Eagle Claim

In addition to soliciting the court to place this strained construction on the Eagle claim, appellee contends that "The only new feature found by the patent office in the Eagle wrench over the prior art cited was Eagle's spring bolt 8 for holding the piece 4 in different positions." This sentence is the initial statement in that portion of appellee's brief termed Topical Index of Dominating Facts. In addition appellee summarized this contention in slightly different words on page 7 as follows: "The new feature which distinguished this substituted claim from the prior art, as found by the Examiner, is the last italicized element of said claim."

THE CONCLUSION THUS ARRIVED AT IS NOT BASED UPON ANYTHING IN THE RECORD OR IN THE FILE WRAPPER. IT IS A CONCLUSION DRAWN BY APPELLEE TO SUIT ITS PARTICULAR DEFENSE AND APPELLANT CHALLENGES APPELLEE TO POINT OUT ANY FINDING BY THE EXAMINER TO THIS EFFECT. IT IS OBVIOUS THAT IF IT IS NOT THE PATENT OFFICE'S HOLDING, THE ENTIRE DEFENSE FALLS WITH ITS MAJOR PREMISE.

Appellee's own brief points out the fallacy of said contention as clearly as possible. The argument of Eagle when presenting the allowed claim points out the differences of the claimed structures over the prior art cited by the Examiner. **Said statement is just as pertinent with respect to Edmands and Fairchild as it is with respect to Miottel, Helstrom, and the other references cited by the Examiner.** The contention of Eagle as an applicant is as follows:

“The two new claims now presented for consideration are thought to be allowable, inasmuch as none of the references show a socket support in the form of a solid body having one end **pivotaly secured** to the handle and the other end adapted **to be slidably received in the bore of the nut engaging socket.** With this construction applicant needs no fastening means for holding the socket support and the socket together depending merely upon the frictional engagement between the parts. The references also fail to disclose **a socket support and socket assembled together and held against relative pivotal movement, the socket support being pivotaly secured onto the handle** and adapted to be held at various positions with respect thereto.”

Appellee's contention that the novelty of the entire combination is based upon the novelty of the last paragraph italicized on page five of its brief is obviously an erroneous conclusion, as can be further demonstrated by an examination of the two claims noted on

said page five. The last paragraph in each of said two claims are almost element for element the same. In fact, even the wording of said last paragraphs including said elements, is similar.

In initial claim 4 elements 8 and 9 are termed "a spring pressed catch carried by the shank." In the allowed claim said elements are termed "means carried by the handle." Appellee finds no difficulty in noting that said parts are exactly the same, because it has given them the same reference characters to fix their identity. In claim 4, the operative relation of said parts is described as "riding the rounded end of the head and engagable with an indent provided in the head." In the allowed claim the operative arrangement is described as "engagable with the rounded end of the socket support to hold the latter in different positions." In these statements of operative relation, appellee has also evidenced no difficulty because it was able to identify said parts with the same reference numerals.

It is difficult to conceive how appellee can cite all of this material and then offer to this court its conclusion that "the new feature which distinguished this substituted claim from the prior art as found by the Examiner is the last italicized element of said claims." **It seems clear that the novelty of the combination is based upon the inclusion in the combination of the elements set out in the second and third paragraphs of said allowed claim, as noted in appellee's brief, and as has been pointed out in**

appellant's brief. The inclusion of said elements gives the combination an entirely different mode of operation and an entirely new result. INSTEAD OF PROVIDING MERELY A HANDLE WITH A SERIES OF REMOVABLE HEADS, IT PROVIDES A HANDLE WITH A SOCKET SUPPORT PIVOTALLY SECURED TO SAID HANDLE AND ADAPTED TO BE SLIDABLY ENGAGED BY ONE OF A SERIES OF REMOVABLE STANDARD SOCKETS, THE SOCKET SUPPORT BEING HELD IN ANY OF A NUMBER OF POSITIONS SO THAT IT WILL BE A ONE-HANDED WRENCH.

Appellee's Defense Opposed to Rule Announced in Doble vs. Pelton

Even if appellee's contentions were correct, that the novelty of the entire combination is based upon the novelty of the last paragraph, it would be improper to so establish patentable novelty for the entire combination. It is well established, in this circuit at least, that this is an improper test for invention of a combination. Judge Van Fleet in **Doble vs. Pelton** 186 Fed. 526 said:

"It is well established you cannot construe a patent for a combination, such as this, with reference to novelty as to any distinct separate feature; for that purpose the device is to be judged as a unit, and it is to be determined from its unitary action whether it is a valuable combination or whether a mere aggregation. You cannot take it piece meal and finding that its various elements have been anticipated in different devices of the

prior art, none of which, however, cover all of the elements which are to be found in the combination, and thereby successfully sustain a defense of anticipation. You must find all the elements of the combination or their equivalents in some particular device which is claimed to be an anticipation."

The Examiner's Comments do Not Have the Effect of Findings and in this Case do Not Even Support Appellee's Contentions

The next point raised by appellee and italicized on page 7 is that Edmands' socket member b is the full equivalent of Eagle's socket member 4. This contention is based upon the fact that in **other claims** embodying **other and different combinations** the Examiner held **other** elements in **different** patents were equivalent to member 4 in the Eagle patent.

A similar question was raised by a defendant in the case of **Stetson vs. Snook-Roentgen Mfg. Co.**, 245 F. 654, 656:

"A discussion of questions in the Patent Office in relation to a pending application, as bearing on the construction of the patent later issued therein, must be read in the light of the grounds of the discussion. To detach isolated statements from their setting and ignore the occasion and question that caused their use, generally leads to a mistake."

Appellee seemingly studiously ignores a similar holding that in Baltzley member 12 constitutes a pivoted member equivalent to applicant's number 4

and number 10 is open at both ends. (File Wrapper, page 13, Appellee's Brief, page 6.) This holding is made by the Examiner in connection with substituted claim 1. If there is any persuasive value in the Examiner's comment with regard to equivalency and rejection of **other and different** claims, it is submitted that the rejection of substituted claim one, which accompanied the allowed claim, has greater persuasive value than the holdings upon other different combinations. The said holding, with regard to substituted claim one, brings into bold relief the difference between the rejected matter and the allowed matter. In substituted claim one the combination does not include a socket support having one end pivotly secured between the branches of the shank bifurcation and the other end squared and having a nut engaging socket with a squared bore adapted to slidably receive the squared end of the socket support therein and provided with means for holding said socket support in different positions. The Examiner, by implication, has drawn a distinction between the combinations set out in said substituted claims. In substituted claim one the parts are equivalent because there is no new result produced by the combination. WITH REGARD TO SUBSTITUTED CLAIM 2, WHICH HE ALLOWED, A DIFFERENT HOLDING WAS MADE; NAMELY, THAT SAID PARTS DO NOT CONSTITUTE EQUIVALENT PARTS, AND DEFINE A PATENTABLE COMBINATION.

McClain vs. Ortmyer Case

Basing its argument upon said distorted premises,

appellee has misquoted the well-known case of **McClain vs. Ortmyer** (141 U. S. 419, 427) although said case is entirely opposed to said contention. On page 22 of appellee's brief, an excerpt from said opinion would seemingly state that "certain variations **do not involve invention.**" The court in its opinion in that case holds that questions of invention can not be tested by general definitions. The exact quotation from said case is as follows:

"Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices **do or do not** involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."

There is no Admission of Equivalency Made by Mr. Pendleton

On page 9 of its brief, appellee has made much of an alleged admission on the part of appellant Plomb Tool Company's general manager. In setting out the testimony in narrative form to comply with the rules, sometimes the pertinence of a bit of testimony is lost. Appellant is therefore quoting from the certified copy of the testimony from which the transcript of record was prepared. (Testimony page 25, Transcript 47).

RE CROSS EXAMINATION—

Questions by Mr. Geisler:

Isn't it a mere mechanical expediency whether

you would make that moveable piece (4) of the Eagle wrench male or female, a mechanical choice, choice for convenience of operation.

A. It would—to make this female instead of male might be a mechanical choice, but it would be a very impractical one.

Q. Substituting one for the other is merely a mechanical selection?

A Combination Must be Disclosed Exactly or Equivalently to Constitute an Anticipation; Anticipation is Not Made Out by Showing that the Elements of a Combination are Old Per Se

Appellee has cited the case of **Keene vs. New Idea Spreader Company** (231 Fed. 701, 708) which was decided in the 6th Circuit as being authority for the statement that all of the elements of a claim need not necessarily be found in a single patent. The citation from said case might be good law in said 6th Circuit to enable a defendant to build up a “synthetic” reference from a number of different references and argue that inasmuch as all of the elements are old then the combination is old. It is entirely and exactly opposed to the rule in this Circuit, however, as set out **Doble vs. Pelton** (*supra*), in which Judge Van Fleet said:

“It is well established you cannot construe a patent for a combination, such as this, with reference to novelty as to any distinct separate feature; for that purpose the device is to be judged as a

unit, and it is to be determined from its unitary action whether it is a valuable combination or whether a mere aggregation. You cannot take it piece meal and finding that its various elements have been anticipated in different devices of the prior art, none of which, however, cover all of the elements which are to be found in the combination, and thereby successfully sustain a defense of anticipation. You must find all the elements of the combination or their equivalents in some particular device which is claimed to be an anticipation.”

It is submitted that this opinion by Judge Van Fleet states the general rule and follows the fact that you can take any machine apart and find that it is built up of bolts, nuts, castings, rods, and similar elements which in themselves are old. It is only when these parts are put together in a new and useful manner that a new machine is produced. It is of no persuasive value that the parts of a given machine, tool, device, or article of manufacture may be found in the same or analagous art in different combinations, producing different results.

An Issued Patent Carries with it the Presumption of Validity

As has been pointed out, the presumption of validity of the Eagle patent is not weakened or strengthened by the Examiner's failure to cite **all** of the prior art. The file wrapper shows that the Examiner made several very severe, careful actions, rejecting all of the original claims and rejecting one of the two substituted claims. He drew a very clear distinction between the rejected

substituted claim 1 and the allowed substituted claim 2. This therefore is not a case where a claim was allowed due to inadvertence, inexperience, or neglect.

Appellee cites three cases, the first of which holds that the presumption is **weakened** if better references are not made a record. The second holds that it **affects** the presumption and the third relates to the failure of an examiner to make said references of record only by inference. The pertinent portions of said three citations are as follows:

“We are not unmindful of the presumption of validity arising out of the issuing of the patent. This presumption, however, is a rebuttable, not a conclusive one, and, in this case, is materially weakened by the fact that the Simplon publications were not called to the attention of the patent authorities while the Dennis application was pending and being considered.”

Dennis vs. G. N. Railway, 51 F. (2nd) 796, 800.

“It should be noted that it appears from the record that neither Wightman nor the Potter patent was cited to the Examiner in the Patent Office and were overlooked by him. This circumstance affects the presumption in favor of the validity of the patent from its issuance.”

Westinghouse Co. vs. Toledo Co., 172 F. 361, 392.

“Moreover, we are not faced with the presumption of validity in this respect because of the

Examiner's failure to find Gally as a reference; it is at least open to doubt whether, had Gally been discovered, the claims would have issued."

Hoe Co. vs. Goss Press Co., 30 F. (2nd) 271, 274.

None of these references, however, go so far as to serve as a basis for appellee's contention that "the presumption of the validity of the patent is to that extent overcome and destroyed." Much less do said opinions hold that "The burden thus rests upon plaintiff to establish the patentable novelty in Eagle's patent."

Appellee was Given Full Opportunity to Develop the Prior Art, but After Court's Ruling Failed or Refused to do so

It is difficult to understand how appellee can urge that plaintiffs studiously avoided entering into an investigation of the subject of the differences between the patented structure of the Eagle wrench and the references of record as supplemented by those stated by appellee, defendants below. Defendant was permitted to examine its witnesses with regard to said prior art without objection. The objections interposed by appellants, plaintiffs below, were directed only to appellee's attempt to cross-examine plaintiffs' witnesses on questions not gone into in the direct examination of said witnesses.

It was not considered to be of any substantial aid to this court to include in the transcript all of the matters set out in the certified copy of the testimony. Inasmuch

as appellee has sought to set up that it was "thwarted" in an attempt to pursue such investigation, it is desirable that said questions, objections, holdings, and comments be set out verbatim. The reference to transcript Page 47 has heretofore been set out (Reply Brief page 14) and the portion noted as being narrated in transcript page 140 is set out on pages 87 and 88 of the certified copy of the transcript and is as follows:

Q. Now I am going to ask you to look at the Miottel patent, which is Defendant's Exhibit "G".

MR. RAMSEY: At this time the plaintiff objects to the attempt to qualify this witness as an expert on patent matters, on cross examination, unless the defendant wishes to make him his own witness. These questions were not gone into on direct.

COURT: Sustained.

MR. GEISLER: If Your Honor please, we are trying to show this Court what the difference is in construction, and the advantages; I am trying to show to the Court what is simply in the art, as every mechanic ought to know, and therefore I ask permission to cross examine this witness with regard to the difficulties a mechanic would have in making one piece or the other piece. They have introduced them, and they have read from the patent, this Peterson patent, and I am assuming that he understands what he is talking about. What is the Court's ruling?

COURT: The Court has ruled.

MR. GEISLER: I beg Your Honor's pardon. May I

go on? I don't quite understand. Am I supposed to make him my witness now?

COURT: I don't care whether you make him your witness or not. I say you can't cross examine him on a line which is not parallel to direct examination. He wasn't asked anything about these patents on direct examination, nor anything about anything except cost accounting, and as to certain features of one patent. If you want to go into the cost accounting, that is a different proposition.

MR. GEISLER: And is no objection to my examining this witness about his knowledge of mechanics, if I wish to do it by making him my own witness?

COURT: No, I haven't any objection. Make the attorney on the other side your witness if you want to. Of course that will be subject to their right of cross examination.

Appellee's Defense of a "Synthetic" Anticipation is Vague and Inconsistent

Appellee's defense is based solely upon the fact that the Patent Office did not enter of record the Edmands patent and the Fairchild Patent.

On page 7 of appellee's brief it seemingly is contended that the Edmands wrench is the full equivalent of the Eagle wrench.

At the bottom of page 7 and the top of page 8, the Fairchild patent is discussed, but no conclusion is drawn as to whether appellee contends that Fairchild

also is the full equivalent of the Eagle wrench, or whether appellee contends that Fairchild shows some of the elements set out in the Eagle claim, while Edmands shows other elements. This is rendered doubly vague because on page 20 of appellee's brief appellee concedes that the point made by appellants in their brief that "It is elementary that it is immaterial in a patentable combination that all the elements are old per se" is a correct statement of law.

On page 9 of said brief the contention is made that Edmands could be modified by substituting a socket support and a socket in lieu of the wrench head shown, or that the wrench head could be modified by the use of an adapter, without invention, because said parts are old per se.

On page 11, appellee switches back seemingly to the contention that Edmands, in view of Fairchild, modifying both and selecting parts therefrom, would constitute an anticipation of the Eagle patent.

On the bottom of page 12 and the top of page 13 appellee apparently urges that Fairchild, if modified, might constitute an anticipation of the Eagle patent.

At the bottom of page 13 and through page 14, appellee comments upon the modification of the Edmands patent in which the wrench head is pivotly **secured** to the handle and an adapter is placed in the wrench head. Appellee seemingly indicates that this roundabout method of attaining Eagle's results in a complicated manner and with bulky, expensive devices should be considered. Appellee urges modification upon

modification until entirely different wrenches are produced which function differently and produce different results.

To Make an Eagle Wrench From the Pieces of the Edmands Wrench and the Fairchild wrench Requires their Complete Dismemberment, Redesign or Adaptation, Resulting in a Complete Change in Structure, Function and Result

With most of said contentions it is necessary to use the Edmands wrench as a base. Said wrench comprises a handle terminating in a pair of spaced ears, forming the bifurcated portions of the handle, across which extend a flattened pin. A series of wrench heads, each provided with an integral unstanding slotted ear which, in one position is alined with the flattened portions of the pin, can be detachably and selectively secured to the handle. The wrench heads can become detached inadvertently when said slot is alined with the flattened pin and it is necessary to use the wrench in said position. (Tr. 106) Said wrench heads would be continually falling off (Tr. 149) and when said parts aline they catch and require the use of both hands to operate the wrench. (Tr. 147).

To modify the Edmands wrench so that it would be an Eagle wrench it is necessary first to make the wrench head and the handle inseparable, that is, pivotally **secured** to each other. As was admitted to appellee's expert Kelly (Tr. 107) the closing of the eye in Edmands as suggested by appellee's counsel would destroy its

utility as a handle with a removable head. The first step proposed thus would be a step backwards and would change the function and result of the Edmands wrench. The next suggestion is made that the wrench head instead of being a wrench head could be merely a socket support which was clearly not contemplated by Edmands in his patent, or even suggested therein. The next proposal is that the wrench head could be used and an adapter could be placed therein so the wrench head and adapter together would constitute a socket support. This would be a still further step backwards as it would destroy the utility of the wrench head and would require an additional piece.

The testimony of C. F. Carlborg formerly in charge of the shop end of appellee's business is that the Edmands wrench costs at least twice as much as the Eagle wrench. If to said cost the cost of an adapter would be added, a still greater variance in price would result. In addition the wrench head, adapter and socket would increase the assembled length of the parts thus built up until they would be too bulky. Somewhat the same experiment was made in the design of the Peterson wrench, (Plaintiffs Exhibit 8, Tr. 130) but was unsuccessful because "It cost more to manufacture, as it took slightly more material than the wrench XXX made on the Eagle pattern" and would not "operate in such a small space." (Tr. 135.)

The Fairchild wrench on the other hand is a ratchet wrench and is pivotally mounted in its handle merely to secure reversal of action. That is, if the head is arranged

in one manner it will give right-handed action and if the head is reversed it will give left-handed action. The head is pivoted merely to eliminate the necessity of a setting-ring commonly provided in wrenches of this character to reverse their action.

On cross-examination appellee's counsel spent substantial time (Tr. 42) questioning M. B. Pendleton about universal wrenches which also have pivoted head. On redirect said witness differentiated universal type wrenches and ratchet wrenches from flex-handle wrenches. This witness testified "that these wrenches cannot be used interchangeable but each has its own specific usefulness, each functioning in its own field, and in most instances said uses or functions do not overlap." (Tr. 46). Thus the Fairchild wrench, which is a ratchet wrench, does not even have the same uses as a flex-handle wrench although both use standard sockets and both are used for fastening and unfastening nuts upon bolts.

All of Proposals to Redesign Edmands Wrench are Modifications Proposed from "Hindsight Rather than Foresight"

All of the proposals made by appellee to aid its defense that the Edmands wrench or the Fairchild wrench can be modified piece by piece until the Eagle wrench is approximated are viewed from "hindsight rather than from foresight." There is no evidence that anyone perceived or conceived that a one-handed, flex-handle wrench, adapted to use standard sockets could be devised in a simple, inexpensive manner and that said

wrench would solve the problem of a multi-purpose wrench so long sought for by the entire wrench art. It is only after the problem is solved that appellee interposes its defense that the new results can be attained if some prior wrenches are dismembered and their parts used to build a new and different wrench differing in structure, function, and result. As was stated in the late case in this, the 9th Circuit, **Banker's Utilities Co. vs. Pacific National Bank** 18 Fed. (2nd) 16, 18:

“Anticipation is not made out by the fact that a prior existing device, shown in a prior patent, may be easily changed so as to produce the same result as that of the device of the patent in suit where the prior device was in common use, without it occurring to anyone to adopt the change suggested by the patent in suit.”

Case of Brady vs. Atlantic Works

Appellee herein has cited the case of **Brady vs. Atlantic Works** 107 U. S. 192, 200, which represents probably the furthestmost swing of the pendulum of judicial interpretation towards strict and narrow construction of patentable invention. Bearing in mind that appellee herein is a deliberate infringer and has copied appellant's patented wrench even as to minute details of construction it is difficult to understand how appellee can even suggest that the creators of said wrench which it deliberately copied are “speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy

tax upon the industry of the country, without contributing anything to the real advancement of the arts."

It is submitted that the deliberate copying and the pirating of a competitor's patented product is not an "honest pursuit of business." If appellee has any "fears and apprehensions of concealed liens and unknown liabilities to law suits," it was warned of said liens and potential liabilities before it commenced its deliberate infringement. The particularly pertinent portion of said citation is that appellee may be embarrassed by "vexatious accountings for profits."

An Inventor Who Has Made a Meritorious Contribution to the Art Should Receive Fair Compensation for His Rights, Especially from a Deliberate Infringer

The inventor, Samuel Eagle, has devised a wrench which has proved to be of substantial value to the wrench art. He has disclosed said invention to the government through the United States Patent Office and as a consideration for said disclosure has been granted a limited monopoly upon said invention. It is submitted that the art is advanced by such disclosures and the entire country is benefited by giving to inventors compensating consideration when they have made meritorious inventions.

"The court should be clearly convinced of the rectitude of its position before holding a patent invalid at the instance of an infringer who has copied the patented combination down to its minute details . . . We agree that if there be a

doubt, the presumption of novelty and invention arising from the patent should resolve that doubt in favor of the complaint.”

Brunswick vs. Wolf 222 Fed. 916 (C.C.A.)

It is submitted that the claim in the Eagle patent defines a patentable combination, involving invention.

Respectfully submitted,

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JAUREGUY & TOOZE and
W. ELMER RAMSEY,
Solicitors for Appellants.

